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REMARKS

Applicants have thoroughly considered the Examiner's remarks and the application has been amended in light thereof. Claims 1-40 are presented in the application for further examination. Claims 1, 3, 4, 10-11, 17-20, 24, and 28 have been amended and claims 34-40 have been added by this Amendment A. Reconsideration of the application claims as amended and in view of the following remarks is respectfully requested. The following remarks will follow the sequence of the Office action. The Arabic numerals beginning each paragraph correspond to the numbered paragraphs of the Office action.

Claims 19 and 20 have been amended to depend from claims 18 and 19, respectively, so that the rejection based on 35 U.S.C. §112, second paragraph may be withdrawn.

Claims 1-13, 15, 16 and 28-33 stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. The Examiner argues that "these claims do not fall within the technological arts because no form of technology is disclosed or claimed." Applicants request reconsideration of this rejection. First of all, the claims recite statutory subject matter because they relate to technology. Second of all, 35 U.S.C. §101 does not require the recitation of technology.

As to the first point, claims 1-10 recite a method including providing options, receiving a selection from the options and delivering a product. Thus, claims 1-10 include the technology of providing information (options), receiving information (selected options) and delivering a product. Similarly, claims 11-14 specifically recite the steps of collecting information. Similarly, claims 28-33 specifically recites the step of receiving and identification. Thus, each of

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the claims, contrary to the Examiner's assertion, is directed to a technology and recites statutory subject matter 35 U.S.C. §101.

In addition, there is no basis for the Examiner's requirement that the claims recite a technology. 35 U.S.C. §101 includes any process or method. Since each of the rejected claims recites a method, each rejected claim specifies subject matter which falls within the statutory definition of 35 U.S.C. §101. There is no case law to support the Examiner's requirement that the claims must recite some type of technology. To the contrary, case law has confirmed that even methods of doing business are statutory subject matter. See State Street Bank & Trust v. Signature Financial Group, Inc., 149 F.3d 1368, 47 USPQ 2d 1596 (Fed. Cir. 1998), cert. denied, 525 U.S. 1093, 119 S.Ct. 851 (1999). As a minimum, the recitation cited herein may be viewed as a method of doing business. In any case, the rejection based on 35 U.S.C. §101 is improper and must be withdrawn. If the Examiner persists in maintaining this contrived rejection, applicants request that the Examiner cite case law to support the requirement that claims must recite technology.

Claims 1, 5, 8, 10-12, 14 and 28-33 stand rejected under 35 U.S.C. §102(a) as being unpatentable over the Direct Marketing reference. Regarding claim 1, the Examiner argues that the Direct Marketing reference discloses a method of providing a consumer with a product including providing the consumer with a first list of options and a second list of options, citing page 2, line 43. This section of the Direct Marketing reference refers to customized toilet paper imprinted with the name of a boat, airplane or business, or any photograph. It is not seen how this constitutes providing a consumer with a first option

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list and a second option list. At best, this would be viewed as a single option list. In any case, the reference fails to suggest that the consumer is provided with a list of options. This reference appears to be nothing more than a mere suggestion that the consumer can select some type of graphic to be added to the toilet paper. Thus, the Examiner must withdraw his rejection of claim 1 and claims 5, 8 and 10 depending therefrom because this reference does not teach providing a first list of first options and providing a second list of second options as recited by claim 1.

Furthermore, claim 1 has been amended to specify that the supplier identifies a first feature of the absorbent product and identifies a second feature of the absorbent product and that each of these features includes a plurality of options which are different. There is no suggestion in the Direct Marketing reference that this aspect of the invention may be employed. Thus, amended claim 1 and its dependent claims (5, 8 and 10) are distinguishable over the Direct Marketing reference so that the rejection based on 35 U.S.C. §102(a) must be withdrawn.

Regarding claims 5, 8 and 10, the Examiner refers to the Direct Marketing reference, cites the claim language and concludes that the two or three lines of the Direct Marketing reference teach each and every aspect of claims 5, 8 and 10. Applicants obviously disagree since there is no basis for this rejection. For example, claim 5 recites facial tissue, not toilet paper and recites a specific grouping of features. This grouping in the context of facial tissue is not present in the Direct Marketing reference. Similarly, claim 8 recites a facial tissue product and that the second feature is tissue packaging graphic design. This is not taught by or suggested in the Direct Marketing reference. Similarly, claim 10 recites

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producing a facial tissue with the first and second option selected by the consumer. Since the Direct Marketing reference only teaches one option, claim 10 is patentable thereover.

Regarding claim 11, applicants submit that the recited method is patentable over the Direct Marketing reference for the same reasons as noted above with regard to claim 1. In particular, the method includes the steps of collecting information relating to a first feature including a plurality of first options and collecting information relating to a second feature including a plurality of second options. It is not seen how the Direct Marketing reference has any disclosure or suggestion relating to collecting such information. Furthermore, claim 11 specifies providing the consumer the produced absorbent paper product having the first and second options. Since the Direct Marketing reference only discloses providing a single option to the consumer, this recital alone is part of the method of claim 11 and distinguishes over the Direct Marketing reference. Thus, the rejection of claim 11 and claims 12 and 14 dependent therefrom must be withdrawn.

Regarding claim 12, applicants do not understand how the cited reference suggests a method wherein the absorbent paper product is selected from the group consisting of facial tissue, toilet tissue, paper towel, napkin, and baby wipe products. Applicants do not see this list of products in the Direct Marketing reference. Since the Direct Marketing reference only discloses a single product with a single option, it cannot disclose the list of absorbent paper products having the first and second options as specified by claim 12.

The Examiner's rejection of claim 14 is improper and must be withdrawn. There is no basis under the MPEP or under the Rules for rejecting a claim for the unspecified reasons

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purportedly set forth by the Examiner. Claim 14 recites that collecting includes collecting the information from the consumer via a kiosk. "Kiosk" is a structural element which limits the collecting. With regard to method or process claims, it is proper to further limit a recitation such as collecting within the context of collecting via a kiosk. Thus, the Examiner must remove the rejection of claim 14 because there is no valid basis for the rejection. Furthermore, the basis for the rejection of claim 14 is unclear. The Examiner refers to the Forseth patent although the rejection of claim 14 is based solely on the Direct Marketing reference under 35 U.S.C. §102(a). In any case, the Forseth reference is deficient for the same reasons that the Direct Marketing reference is deficient and neither of these references teach the use of a kiosk to collect the consumer information.

Claim 28 and dependent claims 29-33 also stand rejected based on the Direct Marketing reference. Claim 28 has been amended to specify that the supplier identifies a plurality of different graphic designs of the packaging, one of which is selected by the consumer. The supplier incorporates a selected graphic design and provides the product with packaging incorporating the selected design to the consumer. This is in contrast of the Direct Marketing reference cited by the Examiner which teaches, to the contrary, that the consumer provides the graphic design information relating to the product to the supplier rather than the supplier identifying the different graphic designs for the packaging and the consumer selecting one. Thus, it is submitted that claim 28 and the claims depending therefrom are patentable over the Direct Marketing reference. Similarly, as noted above, claim 29 is patentable because it relates to facial tissue, an aspect not taught by the

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Direct Marketing reference. Claim 30 is patentable because it further adds a second graphic design to the packaging. Claims 31-32 are patentable because they define the graphic design which is identified by the supplier. Claim 33 is patentable because it specifies providing only to said consumer.

Claims 2, 4, 6, 7, 13, 15-21 and 23-27 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the Direct Marketing reference in view Forseth (U.S. Patent Publication No. 2002/0004749A1). The Examiner admits that the Direct Marketing reference fails to disclose a communication network or method of producing facial tissue products based on selection information collected from a consumer and the supporting communications network. The Examiner points to Forseth as teachings these aspects of the invention. However, Forseth is deficient for the same reasons as noted above with regard to the Direct Marketing reference. Furthermore, although the Forseth publication is entitled "Customized Food Selection..." it is essentially teaching the addition of food additives or ingredients. In contrast, the invention relates to the features of absorbent products wherein the features have a plurality of options. Thus, applicants submit that the combination of the Direct Marketing reference and the Forseth publication are inconsistent because these references teach away from each other.

Regarding claim 2, the Examiner points to paragraph 13 of Forseth wherein it states that "the consumer customizes known products as to quantity and type of various additives...." However, applicants note that this is presented by Forseth in the context of the addition of ingredients and not on the basis of varying features of the product, each feature having a plurality of options, as recited by claim 2. Thus, claim 2 is patentable over the Forseth reference when combined with the

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Direct Marketing reference. The Examiner points to lines 6-8 of paragraph 13 as teaching options for product packaging graphic design. However, applicant does not understand this reference since these lines refer to an ingredient list. Thus, it appears that claim 4 is similarly patentable.

Regarding claims 6 and 7, the Examiner points to Figure 1 of Forseth as relating to the communications network. However, both of these claims depend from claim 1 which specifies identifying features of the absorbent product, wherein each feature has a plurality of options. Once again, as noted above, Forseth teaches away from this aspect of the invention by suggesting the addition of ingredients rather than a feature of a product having a plurality of options. Thus, claims 17-21 and 23 are patentable over Forseth in view of the Direct Marketing reference so that the rejection should be withdrawn.

Similar arguments are applicable to claims 24-27 which are also distinguishable over Forseth. These claims recite receiving information relating to options of features of a custom facial tissue product and producing such a product. In contrast, Forseth limits its teaching to additives and not optional features of a custom facial tissue product. Thus, the combination of Forseth and the Direct Marketing reference is inadequate to make the recited invention obvious.

Claims 3, 9 and 22 stand rejected under 35 U.S.C. §103 as being unpatentable over the Direct Marketing reference, Forseth and further in view of the Adweek reference. The Examiner admits that the Direct Marketing reference in combination with Forseth fails to teach scented and unscented absorbent paper products. The Examiner points to the Adweek reference and speculates that this reference allows the selection of a scented or unscented product. In fact, a fair reading of the reference

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indicates that the Adweek reference teaches nothing more than sending a postcard with a scent. In contrast, claim 3 recites identifying product scent as a first feature and including unscented as one of the options. This aspect is not taught by the Adweek reference. Similarly, claims 9 and 23 which relate to specifying a scent are distinguishable over the Adweek reference which does not suggest that the consumer select from a plurality of various scents. In any case, the scents would only be one feature of the product whereas the claims are directed to multiple features with multiple options. Thus, the Examiner must withdraw his rejection of claims 3, 9 and 22 based on the Adweek reference.

Claims 34-40 have been added to further claim the invention. Claim 34 is similar to claim 1 and recites that the second feature relates to packaging. Thus, claim 34 is patentable for the same reasons as claim 1 and at least for the additional reason that the prior art does not suggest a first feature of the absorbent product and a second feature of the packaging. Claims 35-39 further define the first and second feature, which defined features in combination are not taught by the prior art. Claim 40 depends from claim 28 and adds product features, the combination of which is not in the prior art.

The other cited art is cumulative and no more relevant than the references already applied by the Examiner. Thus, the claims as amended distinguish over the prior art and are patentable.

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Claim 1 has been amended as follows:

1. A method in which a supplier [of providing] provides to
a consumer [with] a custom absorbent paper product, the method
comprising the supplier:

identifying a first feature of the absorbent product

5 wherein the first feature includes a plurality of first options;

identifying a second feature of the absorbent product

wherein the second feature includes a plurality of second
options, wherein the second feature is different from the first
feature and wherein each of the plurality of second options is
10 different from any of the plurality of first options;

providing to the consumer [with] a first list of the first
options for [a] the first feature of [an] the absorbent paper
product[, and];

providing to the consumer a second list of the second
15 options for [a] the second feature of the absorbent paper
product;

receiving from the consumer a selection of one of the first
options from the first list, a selection of one of the second
options from the second list, and a purchase order for a
20 particular absorbent paper product having the first and second
options selected by the consumer; and

delivering to the consumer the particular absorbent paper
product having the first and second options selected by the
consumer.

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Claim 3 has been amended as follows:

3. The method of claim 2 wherein the first feature is product scent, and wherein the first options for the product scent include unscented.

Claim 4 has been amended as follows:

4. The method of claim 2 wherein the first feature is product packaging graphic design, and wherein the first options for the product packaging graphic design include a predefined graphic design, no graphic design, and a graphic design supplied by the consumer.

Claim 10 has been amended as follows:

10. The method of claim 8 further comprising producing, in response to the receiving, a particular facial tissue product having the first and second options selected by the consumer.

Claim 11 has been amended as follows:

11. A method in which a supplier provides to a consumer [of producing] an absorbent paper product to order, the method comprising the supplier:

collecting information from [a] the consumer relating to [one or more] a first desired feature[s] of [an] the absorbent paper product wherein the first desired feature includes a plurality of first options and wherein the information collected from the consumer identifies one of the plurality of first options;

10 collecting information from the consumer relating to a second desired feature of the absorbent paper product wherein the second desired feature includes a plurality of second

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15 options, wherein the information collected from the consumer identifies one of the plurality of second options, wherein the second desired feature is different from the first desired feature and wherein each of the plurality of second options is different from any of the plurality of first options;

20 receiving a purchase order from the consumer for [an] the absorbent paper product wherein the purchase order specifies the identified one of the plurality of first options and the identified one of the plurality of second options; [having the one or more desired features; and]

25 producing the absorbent paper product having the [one or more desired features] the identified one of the plurality of first options and the identified one of the plurality of second options; and

providing to the consumer the produced absorbent paper product having the first and second options in accordance with the information collected from the consumer.

Claim 17 has been amended as follows:

17. A system for use with a communications network, said system being used by a supplier for producing a custom absorbent paper product desired by a consumer, said system comprising:

5 a network interface accessible to the consumer for receiving information from [a] the consumer over [a] the communications network, said information relating to a first option of a first plurality of first options of a first feature and a second option of a second plurality of second options of a second feature [one or more features] of [an] the absorbent

10 paper product desired by the consumer, wherein the second option is different from the first option and wherein the second feature is different from the first feature; and

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15 a production machine linked to the communication network
and configured to receive the information provided by the
consumer [over] via the communications network, [and] said
production machine configured to produce [the] custom absorbent
paper products including any one of the first plurality of
options of the first feature and including any one of the second
plurality of options of the second feature, wherein said
20 production machine produces the custom absorbent paper product
as desired by the consumer and in accordance with [based on]
said information such that the produced custom absorbent paper
product includes the first option and the second option.

Claim 18 has been amended as follows:

18. The system of claim 17 further comprising a computer server operatively connected to the production machine and the communications network, wherein the computer server is configured to receive said information from the consumer [over]
5 via the communications network, and to provide said information to the production machine.

Claim 19 has been amended as follows:

19. The system of claim [19] 18 wherein the production machine is configured to automatically produce the absorbent paper product desired by the consumer in response to receiving said information from the computer server.

Claim 20 has been amended as follows:

20. The system of claim [20] 19 wherein the production machine includes a packager configured to automatically package the absorbent paper product desired by the consumer.

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Claim 24 has been amended as follows:

24. A method in which a manufacturer produces [of producing] a custom facial tissue product for a consumer, the method comprising the manufacturer:

receiving information from the consumer [over] via a communications network, said information relating to [one or more optional features] a first option of a first plurality of options of a first feature of the custom facial tissue product and relating to a second option of a second plurality of options of a second feature of the custom facial tissue product wherein the second option is different from the first option and wherein the second feature is different from the first feature;

providing said information to a production machine linked to the communication network and configured to receive the information provided by the consumer via the communications network, said production machine configured to produce custom facial tissue products including any one of the first plurality of options of the first feature and including any one of the second plurality of options of the second feature; and

producing by the production machine the custom facial tissue product as desired by the consumer and in accordance with the information received from the consumer such that the produced custom facial tissue product includes the first option and the second option [and provided to the production machine].

Claim 28 has been amended as follows:

28. A method in which a supplier [of customizing] customizes packaging for an absorbent paper product for a consumer, the method comprising the supplier:

identifying a plurality of different graphic designs of the 5 packaging;

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receiving from the consumer an identification of a selected one of the plurality of [a] graphic designs and a purchase order for a custom absorbent paper product having packaging embodying the selected one of the graphic designs;

10 incorporating the selected graphic design [received from] identified by the consumer into [the] packaging for an absorbent paper product to thereby produce the custom absorbent paper product having the packaging ordered by the consumer; and
providing the custom absorbent paper product having the
15 packaging including the selected graphic design to the consumer.

Claims 34-40 are new.

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CONCLUSION

It is felt that a full and complete response has been made to the Office action and, as such, places the application in condition for allowance. Such allowance is hereby respectfully requested. If the Examiner feels, for any reason, that a personal interview will expedite the prosecution of this application, he is invited to telephone the undersigned.

Please charge Deposit Account No. 19-1345 in the amount of \$192 to cover the fee for the additional claims added by this Amendment A. If the Commissioner determines that any other fees are due, please charge Deposit Account No. 19-1345.

Respectfully submitted,

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